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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/914,536	08/19/1997	MICHAEL J. STEVENSON	STEVE-106	8667

7590

07/03/2003

ROBERT E. STRAUSS
74527 Moss Rose Drive
Palm Desert, CA 92260

EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 07/03/2003

39

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/914,536

Applicant(s)

STEVENSON ET AL.

Examiner

Erma C. Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-53 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 47-53 and 55-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Applicant's arguments filed 2/21 and 6/18/2003 have been fully considered but they are not fully persuasive.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The rejection of Claims 47-53 and 55 under 35 U.S.C. 112, first paragraph, is withdrawn because of the amendments filed 2/21 and 6/18/2003.

4. Claims 56 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The expressions, to blend or to mix the composition into the polyethylene surface, are new matter. The examiner cannot find where in the specification as originally claimed these expressions were used. With regard to applicant's claim that these terms are permissible because they are found in the "parent-in-part" application, 08/566906, application 08/566906 is only a priority in part.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The rejection of Claims 47-53 and 55 under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendments filed 2/21 and 6/18/2003.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 47-53 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/23041.

'041 teaches a thermoplastic spray material for bonding to polyethylene (p4) where the composition comprises 5-95% polyolefin powder (which would be inclusive of polyethylene powder) with particle size less than 50 microns (p18-19), organic or inorganic pigments or mixtures, organic solvents or water or mixtures (p19), and resin particles such as rosins or hydrocarbon resins (p21). After application to a surface, the composition is heated (p20).

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The composition of '041 overlaps with applicant's claimed ranges.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

08/566906 is not considered a parent application in granting a priority date. Independent claim 1 of 08/566906, claiming a liquid carrier of either inert organic solvent or water/particles that can range from polymers to metals (and not necessarily polyethylene powder)/binder is considerably different than independent claims 47 and 56-58 of the present application, that requires inert organic solvent and polyethylene particles.

The applicant has stated in the 2/21 and 6/18/2003 amendments that

a) '041 does not identify the polyolefin powder as polyethylene. The examiner would argue that polyethylene is a well-known polyolefin, and that polyolefin powder is inclusive of polyethylene powder;

and that

b) "Applicants have found that polyethylene powder...achieves results far superior...specifically superior to the use of the next adjacent homologue, i.e., polypropylene...".

However, the specification at page 4, lines 19-27 identifies a number of powders that can be used in the claimed invention, and nowhere in the specification is it stated that polyethylene is superior to the other powders named.

9. The rejection of Claims 47-53 and 55 under 35 U.S.C. 103(a) as being unpatentable over Howell et al (3432339) is withdrawn because of the 2/21 and 6/18/2003 amendments.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma C. Cameron whose telephone number is 703-308-2330.

The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


ERMA CAMERON
PRIMARY EXAMINER

Erma C. Cameron
Primary Examiner
Art Unit 1762

July 2, 2003